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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/239,016	01/29/1999	MASAMICHI ITO	35.C13284	5590

5514 7590 04/17/2007  
FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
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POON, KING Y

ART UNIT	PAPER NUMBER
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2625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/17/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/239,016

Applicant(s)

ITO, MASAMICHI

Examiner

King Y. Poon

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5,6,9,10 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,9,10 and 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/17/2006 has been entered.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5, 6, 9, 10, 17, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakui (US 6,377,744).

Regarding claims 5, 9: Wakui teaches a camera device (VTR, column 2, lines 45-50) comprising: an image capture unit (camera, column 1, lines 12-16, camera inherently is having and image sensor) adapted to capture an image; an image data generation unit (the device (inherent properties of an video camera) that converts light signal into video signals of column 2, lines 48-50) adapted to generate image data corresponding to the captured image; a specific information generation unit (date time processing circuit, column 2, lines 55-60) adapted to generate specific information (date time information, column 2, lines 55-60) relating to the image data; a recording unit

Art Unit: 2625

(video tape recorder, column 1, lines 12-15) adapted to record the image data and the specific information (column 3, lines 50-65) on the a removable recording medium (tape, inherently is removable recording medium) which is removably attachable to said camera device; a reproducing unit (column 3, lines 55-60) adapted to reproduce the image data and the specific information from the removable recording medium; an embedding unit (combining unit, column 4, lines 10-20) adapted to controllably embed the specific information reproduced from the removable recording medium into the image data reproduced from the removable recording medium; and a control unit (column 5, lines 7-15) adapted to control the embedding unit to embed the specific information reproduced from the removable recording medium into the image data reproduced from the removable recording medium if a first process is selected by a user (desired condition set by user, column 6, lines 50-56), and to control the embedding unit not to embed the specific information (not sent data time information to the combine unit to display the data time information when the video data is displayed, column 5, lines 5-15, column 6, lines 48-67) reproduced from the removable recording medium into the image data reproduced from the removable recording medium if a second process is selected by the user (not displayed is set by user, column 6, lines 50-56).

Note: Wakui teaches the system is control by using control circuit, column 5, lines 1-5, column 2, lines 65-67, and showing a flow chart of one of the controller in fig. 5. It is well know in the art that all control software shown in the flow chart are stored in a computer readable medium.

Regarding claims 6, 10: Wakui teaches to decompress (decodes and expand, column 4, lines 4-10) the image data reproduced from the removable recording medium, wherein, in response to selection of the first process, the specific information reproduced from the removable recording medium is embedded into the image data decompressed (see discussion of claims 5, 9).

Regarding claims 17, 18: Wakui teaches wherein said outputting step outputs the image data into which the specific information is embedded to an external destination (monitor 105, fig. 1) if the first process is selected by the user, and outputs the image data into which the specific information is not embedded to the external destination of the second process is selected by the user (see discussion of claims 5, 9).

Although Wakui disclosed 105 as part of the VTR system, from the drawing of fig. 1, and the discussion of Wakui's invention as a whole, the VTR system without monitor 105 is capable of performing all the limitations as claimed. Furthermore, claim 1 and claim 10 of Wakui clearly teaches the VTR system of fig. 1 minus monitor 105 can be an independent system of its own (see claim 1). Therefore, it would have been obvious to a person with ordinary skill in the art to treat monitor device 105 as external device as suggest by Wakui's claim 1 and 6.

***Allowable Subject Matter***

4. Claims 1, 2, 16 are allowed.

***Response to Arguments***

5. Applicant's arguments with respect to claims 5, 6, 9, 10, 17, 18 have been considered but are moot in view of the new ground(s) of rejection. Please see detailed office action.


***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 12, 2007

  
KING Y. POON  
PRIMARY EXAMINER